

Application No. 10/525317
Reply to Office Action of September 30, 2005

REMARKS

Applicant respectfully request reconsideration in view of the amendment and following remarks. Support for newly claims 18 and 19 can be found in the specification at page 1, lines 22-25.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franz et al. U.S. Patent No. 5,969,199 ("Franz"). The applicant respectfully traverses this rejection.

The European counterpart of Franz EP -A-634383 is disclosed in the applicant's specification at page 1, lines 10-14. The applicant discloses that Franz discloses the manufacture of HFC-125 from tetrafluoroethylene in the presence of an organic nitrogenous base hydrofluoride. The productive output of HFC-125 is 40 mmol per hour and per litre of reaction medium.

One of the objects of the applicant's invention was to make available a process for the manufacture of HFC-125 devoid of CFC-115 with an improved productive output. (see the applicant's specification at page 1, lines 14 and 15).

It is acknowledged that Franz discloses a temperature at col. 2, lines

The reaction temperatures which can be used in the process according to the invention depend on the halogenated alkene employed and in general are -10 to +200 °C. The reaction is preferably carried out above the melting point of the hydrofluoride selected, i.e. in the homogeneous liquid phase, preferably at 0 to +100 °C., particularly preferably at +20 to +80 °C.

Franz teaches halogenated alkanes made with haloalkenes at temperature range from -10°C to 200 °C. The most preferred teaching is to use a temperature range between 20 and 80°C. All the examples (examples 1-17 and comparative examples 1-7) use a reaction temperature between -27°C to 90°C. In fact, most of the examples used a temperature range

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between 25⁰ C and 60⁰ C. The applicant's claimed invention is a selection invention of Franz. The applicant's claimed invention is limited to a specific halogenated alkane (pentafluoroethane) and a specific haloalkylene (tetrafluoroethylene) at a specific temperature (greater than 100°C and not exceeding 160°C). These specific features in the applicant's claimed combination are not taught in Franz. Example 10 of Franz discloses making HFC-125 but only uses a reaction temperature of 55 °C.

The productive output of HFC-125 in Franz is 40 mmol per hour and per litre of reaction medium. By using a high temperature, the applicant was surprisingly able to achieve output of HFC-125 is 180 to 1,700 mmol per hour and per litre of reaction medium (0.18 to 1.7 mole per hour and per litre of reaction medium). These results are clearly unexpected and superior. Enclosed is a declaration from Véronique Mathieu which establishes unexpected results over Franz.

The Examiner must consider the reference as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless the prior art suggested the desirability of such modification (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In

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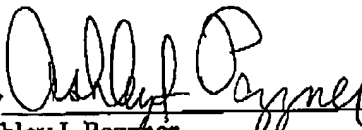
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re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

A two month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05129-00089-US from which the undersigned is authorized to draw.

Respectfully submitted,

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ENCLOSURE: DECLARATION FROM VÉRONIQUE MATHIEU